

**REMARKS**

Entry of the foregoing and reconsideration of the subject application are respectfully requested in light of the amendments above and the comments which follow. Claims 2-6, 8-18, 20, 21, 24, 25 and 28-38 were pending. By the present response, claims 20, 24, 25, 28, 29, 37 and 38 have been amended and claims 32 and 35-36 canceled. Thus, upon entry of the present response, claims 2-6, 8-18, 20, 21, 24, 25 and 28-31, 33-34 and 37-38 remain pending.

Support for the foregoing amendments can be found, for example, in at least the following locations in the original disclosure: the original claims and the drawing figures.

Entry of the foregoing is appropriate pursuant to 37 C.F.R. §1.116 for at least the following reasons. First, the amendments address the new grounds of rejection under 35 U.S.C. §112, second paragraph, thereby reducing the number of issues present upon appeal. Second, the amendments raise no new issues that would necessitate further search and/or substantive reexamination.

***CLAIM REJECTIONS UNDER 35 U.S.C. §112***

Claim 35 stands rejected under 35 U.S.C. §112, first paragraph, on the grounds set forth in paragraph 3 of the Official Action. By the present response, Applicants have canceled claim 35 without prejudice or disclaimer. Reconsideration and withdrawal of the rejection is respectfully requested.

**CLAIM REJECTIONS UNDER 35 U.S.C. §102**

Claims 29, 34 and 35 stand rejected under 35 U.S.C. §102(a) as being anticipated by U.S. Patent No. 4,891,681 to Fiske et al. (hereafter "*Fiske et al.*") on the grounds set forth in paragraph 5 of the Official Action. For at least the reasons noted below, this rejection should be withdrawn.

In one exemplary embodiment, the disclosure provides a sheet-wise binding system that trims the edges of the sheets traveling through the sheet transport path to form a saw tooth edge feature. An example of a saw tooth edge feature is shown in Figure 6, where the saw tooth feature is evident when the trimmed sheets are arranged in a bound folio, such as a book.

The above features are generally embodied in Applicants' claim 29. Claim 29, the only claim subject to this rejection, is directed to a sheet-wise binding system. As set forth in claim 29, the sheet-wise binding system comprises, *inter alia*, a sheet transport path, a trimmer, a stacking system, a binding system, and a controller. The sheet transport path transports a plurality of printed sheets in a sheet-wise manner. The trimmer is configured to trim the edges of the sheets traveling through the sheet transport path to form a saw tooth edge feature. The stacking system stacks the trim sheets and the binding system binds the stacked sheets to form a finished document having the saw tooth edge feature. The controller controls the sheet transport path and the trimmer to trim the edges of the sheets at a varying depth according to a trim schedule to create the saw tooth edge feature. The saw tooth edge feature includes a plurality of document portions, each document portion including a plurality of trim sheets of varying trim depths to expose a surface of a first visible trim sheet of an

adjacent document portion. A portion of the trim sheet removed to the varying trim depth is an entire edge of the trim sheet.

*Fiske et al.* discloses staggering the sides of the sheets so that upon folding the edges become accurately aligned. See Abstract. Staggering is required to compensate for the every increasing distance the sheet must compensate for when folded in a stack (col. 5, lines 27 et seq.). The result in *Fiske et al.* is that the sheets, when assembled and folded in a booklet, all have the same page width, e.g., the edges are not staggered (see Fig. 4).

Thus, in contrast to Applicants' claim 29, *Fiske et al.* does not include a trimmer configured to trim the edges of the sheets traveling through the sheet transport path to form a saw tooth edge feature as presently claimed. Nor does the apparatus of *Fiske et al.* stagger sheets to form a finished document having a saw tooth edge feature as presently claimed. Rather, *Fiske et al.* produces an edge that has all the sheets aligned as disclosed in the Abstract and depicted in Fig. 4.

Further, there is no suggestion in *Fiske et al.* to modify the apparatus to result in the claimed saw tooth edge feature. *Fiske et al.* accumulates on the edges of the sheet and therefore must adhere to the preprogrammed schedule (note the computation of the trim schedule based on sheet position in *Fiske et al.*). To trim the edges in *Fiske et al.* in a manner consistent with the claimed saw tooth edge would result in a loss of the alignment datum used by *Fiske et al.* to position the trimmed sheets. In contrast, the presently claimed system accumulates on the fold allowing trimming of edges as desired, e.g., to a saw tooth, because the edge is not the alignment datum as in *Fiske et al.*, rather the fold is the alignment datum.

Based on at least these differences, it is respectfully asserted that an anticipatory rejection is improper because *Fiske et al.* does not disclose all of the features of claim 29. Dependent claims 34 and 35 are also improperly rejected as anticipated by the disclosure in *Fiske et al.* for at least the same reason as discussed herein with respect to claim 29. Withdrawal of the rejection of claims 29, 34 and 35 is respectfully requested.

***CLAIM REJECTIONS UNDER 35 U.S.C. §103***

Claims 32, 20, 21, 24, 25, 28, 37 and 38 stand rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 5,492,315 to Maruyama et al. (hereafter "*Maruyama et al.*") in view of U.S. Patent No. 4,819,021 to Doery (hereafter "*Doery*") on the grounds set forth in paragraph 7 of the Official Action. This rejection is moot in view of the present amendments, which have canceled claim 32 and presented claims 20, 21, 24, 25, 28, 37 and 38 as dependent on allowed claim 33. Withdrawal of the rejection is respectfully requested.

***ALLOWABLE SUBJECT MATTER***

Applicants note with appreciation the indication that claims 30, 31, 2, 3, 6, 11, 12, 14, 15 and 33 are allowable and that claim 36 would be allowable if rewritten in independent form, as noted in paragraphs 8 and 9 of the Official Action. By the present response, claims 20, 21, 24, 25, 28, 37 and 38 now depend from allowed claim 33 and are therefore also allowable. Claim 36 has been canceled as the features of this claim had been previously incorporated into claim 33.

**CONCLUSION**

From the foregoing, further and favorable action in the form of a Notice of Allowance is earnestly solicited. Should the Examiner feel that any issues remain, it is requested that the undersigned be contacted so that any such issues may be adequately addressed and prosecution of the instant application expedited.

Respectfully submitted,

BURNS, DOANE, SWECKER & MATHIS, L.L.P.

Date: November 29, 2004

Hewlett Packard Company  
Intellectual Property Administration  
P.O. Box 272400  
Fort Collins, CO 80527-2400

(703) 836-6620

By: 

Patrick C. Keane  
Registration No. 32,858

Reg No 50,891